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| 09/751,126 | 12/28/2000 | Maura A. Fitzgerald | WEST 0106 PUS | 7027 |

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| EXAMINER |
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AKINTOLA, OLABODE

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| ART UNIT | PAPER NUMBER |
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3691

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04/03/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 09/751,126 | Applicant(s) FITZGERALD ET AL. | |
| | Examiner OLABODE AKINTOLA | Art Unit 3691 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5 and 7-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5 and 7-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/4/2008 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-2, 5, 7-9, 12-17 and 19-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Templeton et al (US 5679938) ("Templeton") in view of May (US 4658126)

Re claims 1 and 13: Templeton teaches a method and corresponding system for processing a previously issued negotiable instrument, the method comprising: entering at least one negotiable instrument identifier into a terminal (col. 12, lines 18-20); transmitting the at least one negotiable instrument identifier from the terminal to a host computer (col. 12, lines 23-27); receiving, at the terminal, a sign from the host computer, wherein the sign indicates an authorization status of the negotiable instrument (col. 12, lines 2-6);

Templeton does not explicitly teach upon an indication that the negotiable instrument is not authorized for encashment, automatically *printing a mark on a document using a printer in communication with the terminal, wherein the mark corresponds with the sign and indicates that the negotiable instrument is not authorized for encashment*. However, Templeton teaches upon an indication that the negotiable instrument is not authorized for encashment, automatically displaying authorization indicia on a terminal, wherein the indicia corresponds with the sign and indicates that the negotiable instrument is not authorized for encashment (col. 11, lines 35-52; col. 14, lines 55-63; col. 19, line 60 thru col. 20, line 2). Templeton further teaches that, “If the transaction was approved, the authorization indicia will provide a transaction-specific multi-digit approval code that is recorded on the check by the merchant, along with the merchant's identification number. The approval code and merchant identification number may be written by hand, or printed using a suitable printing device”.

May teaches returning a negotiable instrument to a payee with an indication of insufficient funds (col. 2, lines 63-68). Since Templeton teaches *displaying* rather than *printing*, it would have been

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obvious to one of ordinary skill in the art at the time of the invention to modify Templeton to include printing the displayed authorization indicia indicating that the negotiable instrument is not authorized such as when there is insufficient funds as taught by May for the obvious reason of notifying the payee of the reason for disapproval.

Re claims 2, 14 and 15: Templeton and May teach wherein the step of automatically printing a mark on a document comprises automatically printing the sign on the document (see claim 1 analysis above).

Re claim 5: Templeton does not explicitly teach automatically printing the mark on the negotiable instrument. May teaches automatically printing the mark on the negotiable instrument (col. 2, lines 63-68). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Templeton to include printing the displayed authorization indicia indicating that the negotiable instrument is not authorized such as when there is insufficient funds on the negotiable instrument as taught by May for the obvious reason of notifying the payee of the reason for disapproval.

Re claim 7: Templeton does not explicitly teach wherein the step of automatically printing a mark on a document comprises automatically printing a bar code on the document. However, Templeton teaches printing an approval code on the document (col. 14, lines 55-63). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Templeton to include bar code as a form of approval code. One would have been motivated to do

so as a matter of convenience because bar codes can be easily read using bar code reader.

Re claim 8: Templeton teaches wherein the step of entering at least one negotiable instrument identifier comprises entering a serial number of the negotiable instrument (col. 12, lines 9-18).

Re claim 9: Templeton teaches wherein the step of entering at least one negotiable instrument identifier comprises entering an amount of the negotiable instrument (col. 12, lines 18-20).

Re claims 16 and 19: Templeton does not explicitly teach the use of optical reader or bar code for reading the at least one negotiable instrument identifier from the negotiable instrument.

Official notice is hereby taken that optical readers and bar code readers are old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Templeton to include optical reader or bar code reader for reading the identifiers. One would have been motivated to do so in order to ensure that the identifiers characters are better recognized thereby reducing or eliminating errors (optical reader); and bar code reader provides a convenient way of reading bar codes.

Re claim 17: Templeton teaches wherein the terminal further comprises a magnetic ink reader for reading the at least one negotiable instrument identifier from the negotiable instrument (col. 12, lines 7-18).

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Re claims 12, 20 and 22-23: Templeton teaches a method and corresponding system for authorizing a negotiable instrument for encashment, the method comprising: entering at least one negotiable instrument identifier into a terminal (col. 12, lines 18-20); transmitting the at least one negotiable instrument identifier from the terminal to a host computer (col. 12, lines 23-27); receiving, at the terminal, a sign from the host computer, wherein the sign indicates an authorization status of the negotiable instrument (col. 12, lines 2-6); automatically printing the sign on the negotiable instrument using a printer in communication with the terminal (col. 14, lines 55-63).

Templeton does not explicitly teach automatically printing processing instructions on the negotiable instrument if the sign indicates that the negotiable instrument is not authorized for encashment. However, Templeton teaches automatically displaying processing instructions on the negotiable instrument if the sign indicates that the negotiable instrument is not authorized for encashment (col. 11, lines 35-52; col. 14, lines 55-63; col. 19, line 60 thru col. 20, line 2).

Templeton further teaches that, "If the transaction was approved, the authorization indicia will provide a transaction-specific multi-digit approval code that is recorded on the check by the merchant, along with the merchant's identification number. The approval code and merchant identification number may be written by hand, or printed using a suitable printing device" and that the authorization indicia may include an approval code, decline code or a "call center" message (see at least col. 29, lines 13-18 and 35-50; col. 30, lines 13-26)

May teaches returning a negotiable instrument to a payee with an indication of insufficient funds (col. 2, lines 63-68). Since Templeton teaches *displaying or signaling* rather than *printing*, it

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would have been obvious to one of ordinary skill in the art at the time of the invention to modify Templeton to include printing the processing instructions on the negotiable instrument if the sign indicates that the negotiable instrument is not authorized such as when there is insufficient funds as taught by May for the obvious reason of notifying the payee of the reason for disapproval.

Re claim 21: Templeton does not explicitly teach printing void on the document (data content of the mark). However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the method (or structurally programmed) steps recited. The steps would be performed the same regardless of data contents. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of Patentability, see *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to one of ordinary skill at the time of the invention to have printed any type of data content (mark). Such data content does not functionally relate to the steps and the subjective interpretation of the data content does not patentably distinguish the claimed invention

Claims 10-11 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over unpatentable over Templeton in view of May and further in view of Gustin et al. (US 5897625) (“Gustin”)

Re claims 10-11: Templeton does not explicitly teach wherein the negotiable instrument is a money order or a gift certificate. Gustin teaches automated document cashing system.

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Specifically Gustin teaches encashment of negotiable instruments including money order after a confirmation is received from a banking network (abstract, col. 17, lines 38 through col. 18, lines 22, Figs. 17A-B). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Templeton to include encashment of document (negotiable instrument) as taught by Gustin. One would have been motivated to do so in order to provide easy cash access to holders of such instrument and by ensuring the authenticity of such instruments.

Re claim 18: Templeton does not explicitly teach wherein the terminal further comprises an image scanner for scanning the negotiable instrument so as to obtain the at least one negotiable instrument identifier. Gustin teaches wherein the terminal further comprises an image scanner for scanning the negotiable instrument so as to obtain the at least one negotiable instrument identifier (col. 17, lines 45-46). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Templeton to include this feature as taught by Gustin. One would have been motivated to do so in order to retain a copy of the instrument for tracking/audit purposes.

Response to Arguments

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Gallagher et al (US 6003763) teaches a rejection code that signals to the merchant to take further actions (col. 15, lines 27-37).

Templeton et al (US 6547132) teaches a payment terminal for determining the authenticity of document. Templeton further teaches that the payment terminal comprises a printing device configured to print on a roll receipt and further configured to print on a check (or other document, for example, a money order) that is received in the second slot. That is, advantageously, a single printing device may print receipts off of a paper roll or print directly to a check to, for example, fill out the blanks on a check or frank the back of the check as "for deposit." Preferably, the processor is further programmed to, when processing a checking account transaction, print a receipt on the check and treat the transaction as an electronic debit. Printing the receipt may include marking the check as void or processed. Alternatively, when processing a checking account transaction that is a payment by paper check as opposed to an electronic debit of the checking account, the processor is programmed to frank the check as "for deposit." (see at least col. 2, lines 25-31 and col. 3, lines 6-20).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OLABODE AKINTOLA whose telephone number is (571)272-3629. The examiner can normally be reached on M-F 8:30AM -5:00PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

OA

/Hani M. Kazimi/
Primary Examiner, Art Unit 3691